REMARKS

This Amendment responds to the office Action dated September 8, 2004. A diligent effort has been made to respond to all of the objections and rejections contained in the Office Action and reconsideration is respectfully requested.

Applicants thank the Examiner for the courtesy of an interview which took place telephonically on December 1, 2004 with applicants' counsel. In response to this interview, claim 34 has been amended to clarify several issues raised in the September 8, 2004 office action. In particular, the phrase "host computer" now replaces the phrase "host system" in all of the pending claims, and the word "and" has been added between the last two steps of the method claim 34.

A. Rejection of Claim 34

Claim 34 was rejected in the latest office action over Arnold in view of Narayanaswamy. In making this rejection, the Examiner pointed out that the lack of the word "and" between the last two steps of the method meant that only one of the last two steps was required, and thus rejected the claim over Arnold in view of Narayanaswamy on that basis. In addition, the Examiner determined that the phrase "host system" was broad enough to cover the message switch coupled to the web server in Arnold and thus determined that Arnold taught the step of the mobile device sending a first command message to the host system to direct it to transmit the attachment to the mobile device. This phrase has now been replaced with the phrase "host computer," at the Examiner' suggestion, in order to clarify this point. With these amendments in

CLI-1251724v1

place, it is now submitted that the claims clearly distinguish over Arnold in view of narayanaswamy.

As recited in claim 34, a method of forwarding message attachments is set forth. The method includes the following steps: (1) receiving an electronic message at a host computer, the electronic message including a message body and a message attachment; (2) decoupling the message attachment from the message body and storing the message attachment at the host computer; (3) forwarding the message body and information regarding the identity and type of the –message attachment to a wireless mobile data communications device; (4) receiving the message body and the information regarding the message attachment at the wireless mobile communication device; (5) transmitting a first command message from the wireless mobile communication device to the host computer directing the host computer to transmit the message attachment to the wireless mobile communication device; and (6) transmitting a second command message from the wireless mobile communication device to the host computer directing the host computer to transmit the message attachment to an external device capable of processing the attachment.

Arnold and Narayanaswamy do not disclose or suggest all of the steps of this method and thus the 103 rejection must be withdrawn as the combination of these two references cannot make out a *prima facie* case of obviousness. More specifically, Arnold does not disclose any of steps (3), (5) or (6) set forth above, nor does Narayanaswamy. In Arnold, the message switch 104 receives an email with an attachment, it detaches the attachment (Step 210 of Figure 2), and it then puts the attachment onto a remote web site (Step 212). The web site does not receive, store or transmit the email message anywhere, it merely stores the attachment. In place of the attachment, a pointer is provided along with the email message and is transmitted to a message
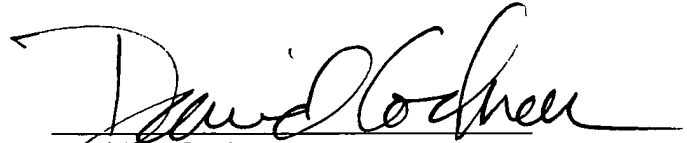
7

recipient. The recipient can then access the attachment on the remote web site using the provided pointer.

In Arnold, however, there is no teaching of providing information regarding the identity and type of the attachment, as set forth in step (3) of claim 34. This information is important to the recipient in that it indicates the type of the attached file, and also may provide some identifier so that the user can determine how to subsequently route and/or process the attachment. In Arnold, there is no such information, and the recipient therefore is not able to determine, a priori, how to route and/or process the attachment. Arnold is also completely missing steps (5) and (6) of claim 34. According to the claim, the user of the wireless mobile communication device is able to send a pair of command messages to the host computer, where the message and the attachment are stored. The first command message is transmitted to the host computer to direct it to transmit the attachment to the wireless device, and the second command message is transmitted to the host computer to direct it to transmit the attachment to an external device. Arnold teaches neither of these steps. In Arnold there is no user control over where the attachment is directed. Instead, the attachments are always sent to the remote web site for subsequent access by the recipient. Because these steps are not disclosed or suggested by Arnold or Narayanaswamy, the 35 USC 103 rejection of claim 34 must be withdrawn.

The new claims 38-52 depend from claim 34 and thus are in condition for allowance. Moreover, these claims recite additional steps and limitations thereto that are not disclosed or suggested by the applied references and thus are independently in condition for allowance.

CLI-1251724v1

Respectfully submitted,

JONES DAY

David B. Cochran
(Reg. No. 39,142)

Jones Day
North Point, 901 Lakeside Avenue
Cleveland, Ohio 44114
(216) 586-7506